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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/734,560	12/13/2000	Atsushi Wakino	FUJI 118	3958

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RABIN & Berdo, PC  
1101 14TH STREET, NW  
SUITE 500  
WASHINGTON, DC 20005

EXAMINER
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NALVEN, ANDREW L

ART UNIT	PAPER NUMBER
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2134

DATE MAILED: 05/20/2004

7

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/734,560

Applicant(s)

WAKINO, ATSUSHI

Examiner

Andrew L Nalven

Art Unit

2134

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 13 December 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                                                                          |                                                                                         |
|------------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                                              | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                                     | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>5.6</u> . | 6) <input type="checkbox"/> Other: _____                                                |

### DETAILED ACTION

1. Claims 1-6 are pending.
2. Information disclosure statements submitted 22 July 2003 and 16 October 2003 have been received and considered.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

4. Claims 1 and 3 are rejected under 35 U.S.C. 102(a) as being anticipated by Kara US Patent No 5,982,506. Kara discloses a method and system for electronic document certification.
5. With regards to claim 1, Kara teaches the email terminal device at the sender's side sending a content certification request email to the email content certifying device (Kara, column 4 lines 57-64) in which the content certification email contains an email address of the email terminal at the receivers side and a text of the content certification (Kara, column 4 lines 40-52), the email certifying device judging whether there is any tampering with the text of the content certification email (Kara, column 4 lines 43-67, column 8 lines 59-65), and if there is no tampering the saving of registration information that contains the text of the content certification in a storage device (Kara, column 9

Art Unit: 2134

lines 33-41), sending a content certified email that contains the text of the content certification to the email device at the receivers side (Kara, column 9 line 42 – column 10 line 11), and sending a receipt email that contains receipt information indicating that content certification has been effected to the email terminal at the sender's side (Kara, column 5 lines 11-22).

6. With regards to claim 3, Kara teaches the content certifying device issuing a settlement request command to a settling institution to settle a fee for a content certifying operation of the text of the email on a credit card (Kara, column 9 lines 9-32).

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 2 and 4-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over by Kara US Patent No 5,982,506 in view of Micali US Patent No 5,553,145. Micali discloses a system for simultaneous electronic transactions with trusted parties.

9. With regards to claim 4, Kara teaches all that is disclosed above, but fails to teach the sending of a notice email to the receiver and the receiver accessing the content certification email by sending an access key to the email content certifying device. Micali teaches the sending of a notice email containing an access destination in

Art Unit: 2134

a web server and an access key for specifying a receiver to the email terminal device at the receiver's side (Micali, column 12 lines 5-16), sending a receipt email that contains receipt information indicating that content certification has been effected to the email terminal at the sender's side (Micali, column 12 lines 12-13), the email terminal device at the receiver's side accesses the web server using the access destination in the email and sends an access key to the email content certifying device through a web page (Micali, column 12 lines 17-32), the email content certifying device retrieves from the storage device one set of registration information corresponding to the access key received (Kara, column 9 lines 33-41), and allows downloading of said email terminal device at the receiver's side of the text content certification contained in the one set of registration information (Micali, column 12 lines 17-32, and 40-45). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to utilize Micali's method of sending a notice email and having the receiver access the content certification email from a server with Kara because it offers the advantage of proving to the sender that the receiver did in fact receive the sent email (Micali, column 4 lines 5-25, column 11 lines 50-54).

10. With regards to claim 2, Kara teaches the sending of a review request email with receipt information (Kara, column 8 lines 8-12), but fails to teach the judging of the emails for tamper checking. Micali teaches the email content certifying device retrieves from the storage device one set of registration information corresponding to the receivers identifier (Micali, column 12 lines 17-22), and judges whether the receivers email address coincides with the receivers email address in the set of registration

Art Unit: 2134

information retrieved (Micali, column 12 lines 17-26), and only allowing downloading after confirmation (Micali, column 12 lines 22-32). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to utilize Micali's method of sending a notice email and having the receiver access the content certification email from a server with Kara because it offers the advantage of proving to the sender that the receiver did in fact receive the sent email (Micali, column 4 lines 5-25, column 11 lines 50-54) and that the email was received intact and not tampered with (Micali, column 4 lines 26-35).

11. With regards to claim 5, Kara as modified teaches the access key containing a receivers identifier and a receivers email address (Micali, column 12 lines 17-22), the email content certifying device retrieves from the storage device one set of registration information corresponding to the receivers identifier (Micali, column 12 lines 17-22), and judges whether the receivers email address coincides with the receivers email address in the set of registration information retrieved (Micali, column 12 lines 17-26), and only allowing downloading after confirmation (Micali, column 12 lines 22-32).

12. With regards to claim 6, Kara as modified teaches the content certifying device issuing a settlement request command to a settling institution to settle a fee for a content certifying operation of the text of the email on a credit card (Kara, column 9 lines 9-32).

### ***Conclusion***

Art Unit: 2134

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.


14. Franklin et al US Patent No 6,263,436 discloses a method and apparatus for simultaneous electronic exchange using a semi-trusted third party.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew L Nalven whose telephone number is 703 305 8407. The examiner can normally be reached on Monday - Thursday 8-6, Alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Morse can be reached on 703 308 4789. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Andrew Nalven



**MATTHEW SMITHERS**  
PRIMARY EXAMINER  
Art Unit 2137